Supreme Court, U.S.
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No. 01-

IN THE

Supreme Court of the United States

KUSTOM SIGNALS, INC.,

Petitioner,

v.

APPLIED CONCEPTS, INC., and JOHN L. AKER,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Under the doctrine of equivalents a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is an insubstantial difference between the elements of the accused product or process and the claimed elements of the patented invention. This Court unanimously affirmed this well-established doctrine in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). In affirming, the Court held that (1) the doctrine must be applied to individual elements of a patent claim (the "all-elements" rule), and (2) a well-established limit on nonliteral infringement, prosecution history estoppel, applies to an amendment to a claim to avoid prior art. *Id.* at 29, 31-32. The Federal Circuit in a 2-to-1 panel decision held in this case that the all-elements rule was satisfied but then, astonishingly, found no literal infringement and without considering the prior art held that prosecution history estoppel barred the application of the doctrine of equivalents.

This is new law following on the heels of the "complete bar" rule announced and applied by the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) (*en banc*), now on writ of *certiorari* to this Court for review.

The questions presented, therefore, are:

1. Whether a court may apply prosecution history estoppel to equivalents of a limitation in an amended claim without inquiry into the reasons for the amendment.

2. Whether a finding of prosecution history estoppel completely bars the application of the doctrine of equivalents.

3. Whether, when a court determines that all the limitations of a claim are present in the accused device, the inquiry ends and a court must find literal infringement of that claim.

4. Whether, in light of the new "complete bar" rule of *Festo* it is proper to apply prosecution history estoppel both during claim construction, to narrow the literal meaning of the claim language, and during the infringement analysis to bar application of the doctrine of equivalents.

STATEMENT PURSUANT TO RULE 29.6

Petitioner, Kustom Signals, Inc. states that Public Safety Equipment, Inc., Britax International, Inc., and Britax International General Partnership are its corporate parents. Britax International General Partnership has two partners, Britax International S.A., which has a 99.9% interest in the partnership, and Britax Luxembourg SaRL, which has a 0.1% interest. No publicly held company owns 10% or more of the stock of Kustom Signals, Inc.

TABLE OF CONTENTS

	Page
Questions Presented	i
Statement Pursuant to Rule 29.6	iii
Table of Contents	iv
Table of Cited Authorities	vi
Table of Appendices	vii
Opinions Below	1
Statement of Jurisdiction	1
Constitutional and Statutory Provisions Involved	2
Statement of the Case	2
1. The Prosecution History	3
2. The Proceedings Below	7
Reasons for Granting the Writ	10
I. *Certiorari* Should Be Granted Because the Decision Below Conflicts Directly With Decisions of This Court.	11
A. The Federal Circuit failed to make the "essential inquiry" mandated by this Court in *Warner-Jenkinson.*	11

Contents

Page

B. The Federal Circuit used prosecution history estoppel as a "complete bar" to a proper determination of infringement. . . 12

C. Under Supreme Court precedent, prosecution history estoppel may not be applied to a limitation in an amended claim without inquiring into the reasons for the amendment. 15

D. The Federal Circuit has created a system that subjects a patent holder to double prosecution history estoppel. 18

II. *Certiorari* Should Be Granted Because the Decision Below Establishes Law That Will Cause Irreparable Harm to Patent Holders. . . 20

A. The present case exemplifies the harsh consequences of the current method of infringement analysis employed by the Federal Circuit. 20

B. Irreparable harm to the petitioner is avoided by a straightforward application of the law of Warner-Jenkinson. 21

Conclusion 23

TABLE OF CITED AUTHORITIES

Page

Cases:

Bayer Aktiengesellschaft v. Duphar Int'l Research B.V., 738 F.2d 1237 (Fed. Cir. 1984) 16

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed. Cir. 2000) ..... *passim*

Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605 (1950) 11, 15, 19, 20

Hughes Aircraft Co. v. U.S., 140 F.3d 1470 (Fed. Cir. 1998) 12, 13

Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997) ..... *passim*

United States Constitution:

Article 1, § 8, clause 8 2

Statutes:

28 U.S.C. § 1254(1) 1

28 U.S.C. § 1338(a) 3

35 U.S.C. § 112 ..... 2, 10

35 U.S.C. § 271(a) 2

TABLE OF APPENDICES

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Federal Circuit Dated And Decided September 5, 2001 ..... 1a

Appendix B — Memorandum And Order Directing Entry Of Final Judgment And Judgment Of The United States District Court For The District Of Kansas Dated And Filed August 3, 1999 ..... 17a

Appendix C — Memorandum And Order Of The United States District Court For The District Of Kansas Dated And Filed June 18, 1999, As Amended June 29, 1999 ..... 22a

Appendix D — *Nunc Pro Tunc* Memorandum And Order Of The United States District Court For The District Of Kansas Dated And Filed June 29, 1999 ..... 76a

Appendix E — Memorandum And Order Of The United States District Court For The District Of Kansas Dated And Filed July 27, 1998 ..... 78a

Appendix F — Memorandum And Order Of The United States District Court For The District Of Kansas Dated And Filed February 9, 1998 ..... 88a

Appendix G — Order Of The United States Court Of Appeals For The Federal Circuit Denying Petition For Rehearing Dated And Filed October 19, 2001 ..... 118a

Appendices

Page

Appendix H — U.S. Patent No. 5,528,246 Dated June 18, 1996 ..... 120a

Appendix I — Response To Examiner's Action Dated August 31, 1995 ..... 121a

Appendix J — Examiner's Action, Patent And Trademark Office Re Patent Application Dated June 5, 1995 ..... 122a

Petitioner respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit's opinion (per Newman, J., joined by Lourie, J., dissent by Mayer, C.J.) affirming judgment in favor of respondents Applied Concepts, Inc. and John L. Aker (collectively referred to as "Applied Concepts") (App. 1a-16a) is reported at 264 F.3d 1326. The Federal Circuit's order denying a rehearing (App. 118a-119a) is not otherwise published. The appeal to the Federal Circuit was taken from two district court decisions, an order by Vratil, D.J. (App. 22a-77a) published at 52 F. Supp.2d 1260 and an earlier order by O'Connor, D.J. (App. 88a-117a) published at 995 F.Supp. 1229), on motions for summary judgment brought by respondents for noninfringement of U.S. Patent No. 5,528,246 ("'246 patent") (Lodging; L-1 to L-42) owned by petitioner Kustom Signals, Inc. ("Kustom"), and on a motion for summary judgment brought by Kustom for infringement of the '246 patent. The district court granted summary judgment in favor of respondents (see Memorandum and Order Directing Entry of Final Judgment, App. 17a-19a).

STATEMENT OF JURISDICTION

The Court of Appeals for the Federal Circuit entered its opinion and order on September 5, 2001, and denied rehearing on October 19, 2001. Petitioner invokes this Court's jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, § 8, clause 8 of the Constitution provides:

> Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries.

35 U.S.C. § 112, ¶ 6 provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 271(a) provides:

> Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

STATEMENT OF THE CASE

Petitioner, Kustom, and respondents, Applied Concepts, manufacture and sell traffic radar devices and other equipment used by law enforcement agencies. Petitioner

alleges that a traffic radar manufactured by Applied Concepts, known as the Stalker Dual radar, infringes petitioner's '246 patent. This case was brought in the United States District Court for the District of Kansas under 28 U.S.C. § 1338(a).

1. The Prosecution History

The '246 patent is entitled "Traffic Radar with Digital Signal Processing." It discloses the first radar for law enforcement and related applications utilizing digital signal processing (DSP) techniques to process incoming radar return information to identify both the strongest radar return, usually reflected from the target vehicle closest to the radar, and the fastest radar return, even if it is not the strongest signal.[1] Although digital systems were generally known at the time of the '246 invention, they only identified the strongest radar return signal. App. 2a-3a. Kustom's Eagle series traffic radars were introduced in 1993 and were the first to employ the fastest radar return technology. Applied Concepts soon followed Kustom's lead and introduced the Stalker Dual. App. 29a.

The present invention is a pioneer in its field in that it provided the first digital system to process and find both the strongest and fastest radar return signals. The innovation lies in the multi-mode DSP technology, whereby an operator can choose to view either the strongest radar return signal or the signal that corresponds to the highest frequency shift—indicative of a faster moving vehicle. The central claim construction question, as analyzed by both the district court and the Federal Circuit, is whether a limitation directed to

1. This improved DSP radar technology is particularly useful to the law enforcement officer when the fastest vehicle is not the closest target.

searching memory for a signal component that meets preselected magnitude or frequency criteria (both the strongest and the fastest components having already been detected, processed and stored), and indicating a speed associated with the identified component, would be infringed by the Stalker Dual which displays either (1) the speed of the strongest return signal, or (2) the speeds of *both* the strongest and the fastest targets, as selected by the operator. The preferred embodiment of the patented device displays the speed of the target vehicle associated with either (1) the strongest return signal *or* (2) the fastest return signal, as selected by the operator.[2] Both the patented and the accused systems detect, process and store both fastest and strongest data. The difference lies in the *preferred* display method. Notably, nothing in the claims, specification, or prosecution history limits the claimed invention to the preferred embodiment. See Chief Judge Mayer's dissent, App. 15a-16a.

Both the district court and the Federal Circuit used differences between the language of the claims as filed, versus the language used in entirely new claims submitted during prosecution, to support the notion that the prosecution history limited the scope of patent protection to devices that display the speed associated with either the strongest return signal or the fastest return signal, *but not both*. Yet the clauses that

2. Referring to the '246 patent, a remote control is shown in Fig. 2 (Lodging, L-3). It has a control button 280 which enables the operator to select the fastest mode, thereby causing the target speed display window 204 in Fig. 1 (Lodging, L-2) to display the speed of the fastest target vehicle rather than the speed of the strongest target vehicle. In the accused Stalker Dual radar, a second window on the accused device displays the speed of the fastest target vehicle when a control button is pressed to select fastest mode.

the lower courts compared not only came from different claims, but were directed to different aspects of the device. In the patent application as originally filed, claim 1 recited a spectrum validation process and the step of "determining the magnitude and frequency of each valid component." App. 30a. Original independent claim 16 contained similar language (App. 31a-32a). All original claims were subsequently cancelled and new claims were submitted that included limitations directed to other aspects of the invention. The purpose of these changes was not to narrow the scope of the claims to avoid the prior art, but to more distinctly claim the patentable subject matter of the invention. The new claims no longer recited limitations directed to a validation process but rather to the search for stored data. Signal validation (eliminating unwanted signals and noise) still occurs during processing, as disclosed in the specification; and, as disclosed, both the strongest and fastest signals are always processed. The context of the invention must be kept in mind—a digital signal processing system for radar that selectably provides both strongest and fastest return signal data.

Neither the specification nor the prosecution history[3] limited the meaning of "or" to displaying the strongest or fastest signals, but not both. The prior art Muni Quip radar, an analog device cited by the examiner in his rejection, discloses tracking the strongest or fastest target. As Chief Judge Mayer correctly stated in his dissent, the prosecution history does not support the narrowed construction of "or." "[T]he 'or' limitation did not distinguish the invention over

3. The examiner's action rejecting the originally filed claims is reproduced in the Lodging at L-56 to L-60 (App. 122a) and Kustom's response to the action is at L-43 to L-55 (App. 121a).

the Muni Quip MDR-1 radar device because that device also had the capacity to track the strongest or fastest signal." App. 16a.

The cancellation of the original claims and submission of new claims 22-42 (which renumbered became claims 1-21 of the issued '246 patent) directed the claimed invention to different aspects of the patentable subject matter. Lodging, L-43 to L-55. The use of "or" was not a change to the original claims but rather a component of new claims 22 and 37 covering different subject matter. The relevant clause of claim 22 (claim 1 of the patent) reads verbatim as follows: "(e) searching said components in memory for the component that meets preselected magnitude or frequency criteria." Claim 37 (claim 16 of the patent) contains a similar clause. At this point the "and" event of the original claims has already been performed. Now the new claims are directed toward selectability of data presentation. The fact that this device gives the operator the option to select either fastest or strongest data, depending on which is most likely to give the most relevant speeding data given road conditions, is the pioneer development of the instant invention. Whether the device displays one signal or both signals, or just one or the other, is irrelevant to the innovation for which patent protection was sought. The ability to have a choice is what the patented device provides to the public. Nothing in the claims, specification, or prosecution history limits the present invention to an "either one of two alternatives, *but not both*" claim construction. App. 8a (emphasis added). It was error on the part of the Federal Circuit to not perform the element-based infringement analysis required by this Court under *Warner-Jenkinson* and demonstrated by Chief Judge Mayer in his dissent (App. 15a-16a).

2. The Proceedings Below

The district court granted respondents' motions for summary judgment of noninfringement and granted a stay of the proceedings pertaining to all invalidity claims and defenses until the appeal of petitioner's infringement claims is concluded. App. 17a-19a. Petitioner appealed the summary judgment decision of no infringement to the Federal Circuit. The Federal Circuit affirmed. Inexplicably, the court found that all the elements of the claims in controversy were "undisputably" present in the accused device and yet proceeded to analyze infringement under the doctrine of equivalents as an "alternative" presented by the parties. App. 13a.

More particularly, the Federal Circuit found that "all the steps or elements of method claim 1 or apparatus claims 16 and 20 are undisputedly present in the accused device," that "or" was not even an element, and that the ruling of noninfringement could not be sustained on the ground that "or" signified alternative elements! App. 13a. Prior Federal Circuit and Supreme Court case law would have the analysis end here, for having found all the elements or limitations of the claims in the accused device, a decision granting summary judgment of noninfringement could not be sustained. The Federal Circuit, however, did not end the inquiry here but rather gave the respondents another shot at obtaining summary judgment—one based on an "alternative" ground. The court did not explain why a *second* chance to obtain a holding of noninfringement was granted!

The alternative ground used by the Federal Circuit to affirm was one based on infringement through the doctrine of equivalents, which apparently assumes that the "or"

language *is* an element after all, now requiring petitioner to prove an equivalent element in the accused device. Without analyzing the substantiality of differences, the Federal Circuit used an erroneous reading of the opinions of the district court to assert prosecution history estoppel to bar any equivalents to the resurrected "or" element.

In error, the Federal Circuit stated that "[t]he district court correctly concluded that the prosecution history estops Kustom from relying on the position that a device which searches for both fastest and strongest targets performs substantially the same function as a device which searches for either the fastest or the strongest target." App. 14a. *In fact the district court did not find prosecution history estoppel in this case.* App. 62a, n.9.

The Federal Circuit then compounded its error by stating that petitioner amended claims 1 and 16 in response to a rejection by the examiner. App. 14a. In fact, petitioner *canceled* claims 1 through 21 and submitted *new* claims directed to *different aspects* of the invention. The Federal Circuit did not analyze whether the claims were "amended" for reasons related to patentability, did not entertain analyses of reasons that would support a rebuttal of any presumption (such as directing the claims to other aspects of the invention, greater clarity, improved description, etc.), and did not analyze whether the "amendment" was narrowing. Therefore, the Federal Circuit sidestepped the most basic prerequisites for finding prosecution history estoppel: an amendment for reasons related to patentability, an analysis of any intrinsic evidence of reasons not related to patentability, and a determination that the "amendment" narrowed the scope of the claim. *Festo*, 234 F.3d at 566-68.

The differences in claim language were used by the district court to erroneously construe the claims, and by the Federal Circuit to erroneously apply prosecution history estoppel to separate clauses, in separate claims, directed to differing elements of the claimed invention. No analysis of the reasons for the differences was afforded the petitioner upon appeal, however, because of the preclusive effect of the new complete bar created by the Federal Circuit in *Festo*. The issues presented on appeal were never analyzed according to principles promulgated by this Court and years of Federal Circuit opinion. Infringement was not analyzed under the all-elements rule of *Warner-Jenkinson* since the analysis was rendered irrelevant by the complete bar applied to a portion of the claim language. The Federal Circuit denied that the claim language (use of the term "or") was an element, yet decided the entire case by finding that prosecution history estoppel limited the meaning of the term to "either . . . but not both." App. 8a.

Despite no finding of prosecution history estoppel by the district court, the Federal Circuit applied prosecution history estoppel to invoke a complete bar to infringement by equivalents. In direct contravention of established law pertaining to infringement analysis, the Federal Circuit sidestepped the issue of literal infringement by a device that contained every limitation of the claims, and applied prosecution history estoppel, not based on argument, intrinsic evidence in the specification, or narrowed claims, but rather on a change in semantics between earlier cancelled claims and claims presented during prosecution.

In his dissent in this case, Chief Judge Mayer quite succinctly laid out the simple logic that should have been

applied to the infringement analysis. First, the plain meaning of "or" is "either or both." If it is stated that if either condition A or condition B is met, C will occur, an ordinary person will certainly expect C to occur if both conditions are met.[4] In addition, when referring to the specification to interpret the claims under 35 U.S.C. § 112, ¶ 6, Judge Mayer found that the flowcharts describe a logic sequence for which it is proper to use the Boolean definition of "or" in order to use the meaning of one skilled in the art. It is well known in the art that "or" can be satisfied by either of two conditions or both. If an "exclusive or" is intended, such that the condition is not satisfied by the occurrence of both events, it must be particularly stated. Judge Mayer properly found that neither the specification nor the prosecution history limited the meaning of "or" to exclude devices displaying both fastest and strongest signals.

The Federal Circuit's holding merits this Court's immediate review because it reflects a dangerous change in infringement analysis. This change was initiated in *Festo*, and as applied in the present case, demonstrates the unworkability and unfairness of the new law.

This petition for a writ of *certiorari* followed.

REASONS FOR GRANTING THE WRIT

The petition should be granted because the ruling of the Federal Circuit conflicts sharply with decisions of this Court and pre-*Festo* Federal Circuit precedent and legislates new

4. Chief Judge Mayer used the following analogy: "If a store owner says, 'If it hails or snows today, we will close the store,' then the owner will still close the store if it happens to hail *and* snow." App. 15a.

and harmful policy limiting the rights of patent owners. The Federal Circuit's decision in this case follows a national rule enunciated in *Festo* that upends settled law. The new "complete bar" created by *Festo*, now under review by this Court and applied in the present case, subverts the required analyses of *Warner-Jenkinson* and *Graver Tank*[5] and virtually negates the ability of patent holders to obtain recourse against copyists under the doctrine of equivalents. Accordingly, consistent with this Court's practice of reviewing appellate decisions in direct contravention of United States Supreme Court opinions, a writ of *certiorari* should be granted.

I. *Certiorari* Should Be Granted Because the Decision Below Conflicts Directly With Decisions of This Court.

A. The Federal Circuit failed to make the "essential inquiry" mandated by this Court in *Warner-Jenkinson*.

The essential inquiry under the doctrine of equivalents as mandated by this Court is as follows: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Warner-Jenkinson*, 520 U.S. at 40. "The determination of equivalence should be applied as an objective inquiry on an element-by-element basis." *Id.*

In analyzing a claim, a court should analyze "the role played by each element in the context of the specific patent claim." *Id.* This analysis "will thus inform the inquiry as to

5. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950).

whether a substitute element matches the function, way and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element." *Id.* In the present case, the Federal Circuit failed to follow Supreme Court precedent and analyze the claims on an element-by-element basis. Following the new complete bar rule, the court by-passed the all-elements rule and erroneously applied prosecution history estoppel to completely decide the case. Substantiality of differences and function, way, result analysis plays no part in the new scheme of infringement analysis created in *Festo* and applied in the present case.

B. The Federal Circuit used prosecution history estoppel as a "complete bar" to a proper determination of infringement.

"The Supreme Court has long recognized that the key to prosecution history estoppel is the surrender or disclaimer of subject matter by the patentee." *Hughes Aircraft Co. v. U.S.*, 140 F.3d 1470, 1476 (Fed. Cir. 1998).[6]

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6. The Federal Circuit opinion in *Hughes Aircraft* provides a pertinent analysis of the law of prosecution history estoppel as formulated by this Court and applied by lower courts prior to *Festo*:

> We reject the government's contention that *Warner-Jenkinson* requires such a wooden approach to prosecution history estoppel. The Supreme Court has long recognized that *the key to prosecution history estoppel is the surrender or disclaimer of subject matter by the patentee*, which the patentee is then unable to reclaim through the doctrine of equivalents. *See Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136, 62 S.Ct. 513, 518-19, 86 L.Ed. 736 (1942)* ("By the

(Cont'd)

In *Festo*, the Federal Circuit held that the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents to a claim limitation regardless of the actual scope of any surrender or disclaimer. This new complete bar rule "simply forecloses all application of the doctrine of equivalents for any amended claim limitation. This approach by-passes the all-elements rule altogether." *Festo*, 234 F.3d at 600 (dissent by J. Michel). As in *Festo*, the Federal Circuit here did not reach a proper infringement analysis under the "all elements" rule because of the preclusive effect of the complete bar.[7]

(Cont'd)

> amendment he recognized and emphasized the difference between the two phrases and *proclaimed his abandonment* of all that is embraced in that difference. The difference which he thus *disclaimed* must be regarded as material, and since the amendment operates as a disclaimer of that difference, it must be strictly construed against him." (citations omitted)); *see also Sutter v. Robinson, 119 U.S. 530, 541, 7 S.Ct. 376, 381-82, 30 L.Ed. 492 (1886)* ("He is not at liberty now to insist upon a construction of his patent which will include what he was *expressly required to abandon* and disavow as a condition of the grant.").

Hughes, 140 F.3d at 1476 (emphasis added).

7. From Judge Michel's dissent in *Festo*:

> The doctrine of prosecution history estoppel supplements the all-elements rule by providing a set of rules for notifying the public whether, and to what extent, the scope of protection is even narrower than what the all-elements rule would allow.
>
> * * *

(Cont'd)

As the present case demonstrates, a copyist may make an insubstantial change relating to any claim limitation, and thereby gain the right to practice the claimed invention. A particularly advantageous technique is to alter an element that is required to practice the claimed invention but is unrelated to the novelty (and marketability) of the invention. In this case, the respondents merely altered the manner of displaying the stored data, thereby retaining the benefit of the petitioner's novel application of digital signal technology —the very innovation the patent at issue was procured to protect. Petitioner was defeated from the outset, not through any new development or design by respondents, but by the mere fact that petitioner submitted new claims during prosecution. Under the rule in *Festo*, the new complete bar effectively removes the claimed element from consideration, rather than merely limiting the scope of equivalents.

The new "complete bar," as applied in conjunction with summary judgment practice, leaves very little room for trial in patent cases, whether to the bench or jury—little room for determination of infringement based on the facts since most

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(Cont'd)

> In contrast to the doctrine of prosecution history estoppel we have applied until today, the majority's new complete bar rule does not supplement the all-elements rule as a way to further clarify the scope of equivalents available to the patentee. Rather than attempt to "refine" our case law as to how the added claim limitations should be enforced in light of the substance of the communications between examiner and applicant, the majority's new rule simply forecloses all application of the doctrine of equivalents for any amended claim limitation. This approach by-passes the all-elements rule altogether.

234 F.3d at 599-600.

cases will be determined not by an infringer's activity at all but rather by what occurred during prosecution of the patent application years ago.

C. Under Supreme Court precedent, prosecution history estoppel may not be applied to a limitation in an amended claim without inquiring into the reasons for the amendment.

The Federal Circuit did not analyze equivalence under the law of *Warner-Jenkinson* and *Graver Tank*. Rather, the court applied prosecution history estoppel to one word of the claim language[8] (which the court had just previously found was not an element), held that petitioner was thereby estopped from relying on equivalents to that *non-element*, and affirmed summary judgment since no jury could find infringement under the doctrine of equivalents due to the estoppel. Apart from the unprecedented procedures of (1) applying prosecution history estoppel to claim language, rather than construed elements or limitations, and (2) enforcing a complete bar due to differences in language in distinct limitations in separate claims, the Federal Circuit failed to engage in any analysis of the context of changes made during prosecution of the patent. Even if a presumption of prosecution history estoppel could have been

8. The Federal Circuit found that the very language at the heart of this dispute, the word "or" in claims 1, 16, and 21 was not an element. This begs the question: can a finding of infringement be defeated solely by the application of prosecution history estoppel to a non-element, thereby completely precluding the doctrine of equivalents? If so, the concerns raised in the patent law bar by *Festo* should be considerably heightened by the *Kustom* opinion. App. 1a. A non-element (or non-limitation) of a claim should not be used to defeat infringement when all the elements are "undisputedly present in the accused device." 264 F.3d at 1333.

properly found under the circumstances of case, no opportunity to rebut the presumption was afforded the petitioner.

In order to properly consider rebuttal of the presumption, a court must analyze the reason for an amendment.[9] It is critical to determine, for example, whether material was surrendered to avoid the prior art.[10]

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9. *See Warner-Jenkinson*, 520 U.S. at 33-34:

> The presumption we have described, one *subject to rebuttal* if an *appropriate reason* for a required amendment is established, gives proper deference to the role of claims in defining an invention and providing public notice, and to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application.

See also the pre-*Festo* Federal Circuit opinion *Bayer Aktiengesellschaft v. Duphar Int'l Research B.V.*, 738 F.2d 1237, 1243 (Fed. Cir. 1984):

> [W]henever the doctrine of file history estoppel is invoked, a close examination must be made as to, not only what was surrendered, but also the *reason* for such a surrender.

Naturally, an analysis of the prosecution history may also show that an amendment did not surrender any material at all but rather was undertaken to better describe or clarify the claimed element. *See* J. Linn's dissent in *Festo*, 234 F.3d at 624.

10. The opinion in *Warner-Jenkinson* provides numerous cites to Supreme Court cases where the Court analyzed prosecution history estoppel in terms of the scope of the prior art. *See* 520 U.S. at 31, n.5.

> It is telling that in each case this Court probed the *reasoning* behind the Patent Office's insistence upon a change in the claims. In each instance, a change was demanded because the claim as otherwise written was viewed as not describing a patentable invention at all—typically because what it described was encompassed within the prior art.

Warner-Jenkinson, 520 U.S. at 31 (emphasis added). In this case, the Federal Circuit did not probe the reasoning behind the PTO's rejections or the relationship between the rejections and the actions taken by the patentee to secure allowance of the claims.[11]

Under the new law erroneously promulgated by the Federal Circuit in *Festo*, a patentee may resort to the doctrine of equivalents *only* if a claim amendment was not a narrowing amendment or if the reason for the amendment was not substantially related to patentability—two extremely unlikely scenarios given the normal practice of patent prosecution. The Federal Circuit improperly used prosecution history estoppel to cut short analysis of substantial similarities between the accused device and the claimed invention that would have supported a finding of infringement under the doctrine of equivalents.

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11. Such analysis is no longer required under the complete bar rule in *Festo*, followed though unstated in the majority opinion of the panel in present case.

D. The Federal Circuit has created a system that subjects a patent holder to double prosecution history estoppel.

The Federal Circuit has created a scheme of double prosecution history estoppel fatal to relief under the doctrine of equivalents by using estoppel concepts to drastically narrow the literal scope of a claim and then deny any protection from equivalents containing insubstantial changes—even equivalents to the narrowed scope.

Under the flexible bar approach, supplanted by the complete bar of *Festo*, the prosecution history was considered both during claim construction, to ascertain the meaning of the claims (particularly in light of disclaimers during argument), and during analysis of infringement under the doctrine of equivalents, to estop the patentee from reclaiming material surrendered in order to obtain the patent. This approach was entirely fair and workable because any equivalents in the accused device that were not within the scope of material surrendered could still support a finding of infringement if they represented insubstantial changes to the claim limitation. In other words, under the flexible bar approach, patentees were still protected from copyists.

In light of the new complete bar of *Festo*, the above approach of analyzing the prosecution history, both during claim construction and during infringement analysis, is no longer workable because the scope of the two narrowing analyses are in practice coextensive. They create a double prosecution history estoppel: a circular scheme by which the prosecution history is used to narrow the literal meaning of the claims and then again to completely bar any equivalents to the narrowed scope. A new scheme of infringement

analysis has been created which supports waging an attack on a single element of a claim, leaving no rationale for performing the essential inquiry mandated by *Warner-Jenkinson*.

Using this double prosecution history estoppel, summary judgment of noninfringement is easily rendered and affirmed despite the fact that, as issued, every element of the claim reads upon the accused device.[12] No application of the "all-elements" rule of *Warner-Jenkinson* is necessary since it is bypassed to focus on a single element of an amended claim. No analysis of the substantiality of differences or of the similarity of function, way, or result is required either—a completely efficient and formulaic application of law without messy factual inquiries. This is exactly the situation that this Court attempted to avoid by the ruling in *Warner-Jenkinson*. *See* 520 U.S. at 24-25.[13]

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12. Having narrowed the "literal" scope of a claim sufficiently to exclude the accused device, a court may now move onto infringement under the doctrine of equivalents and, lo-and-behold, find that scant analysis is required because no equivalents are available to supplement the previously diminished scope.

13. The opinion in *Warner-Jenkinson* described some of the considerations that go into applying the doctrine of equivalents by quoting *Graver Tank* as follows:

> What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing

(Cont'd)

II. *Certiorari* Should Be Granted Because the Decision Below Establishes Law That Will Cause Irreparable Harm to Patent Holders.

A. The present case exemplifies the harsh consequences of the current method of infringement analysis employed by the Federal Circuit.

Because the new scheme of infringement analysis promulgated by the Federal Circuit by-passes the all-elements rule and substantially excludes analysis of the scope of subject matter actually surrendered during prosecution, patent holders are rendered helpless against copyists due *solely* to the fact that claims were amended as part of the normal patent prosecution process.

The Federal Circuit has effectively changed the doctrine of prosecution history estoppel from one of a true estoppel—the patentee is estopped from protecting that which he surrendered during prosecution—to a quasi-legislative

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(Cont'd)

> may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

520 U.S. at 24-25 (quoting *Graver Tank*, 339 U.S. at 609).

prosecution history bar by which all equivalents, including those well outside the scope of matter surrendered, are lost.

The present case demonstrates the injustice of the complete bar when taken to its extreme. The Federal Circuit correctly held that the district court's construction of an exclusively alternative "or" element could not sustain a ruling of non-infringement, and that all the elements of claims 1, 16 and 20 were "undisputedly present in the accused device." App. 13a. Yet the court proceeded to apply prosecution history estoppel to completely bar the doctrine of equivalents based on use of the word "or" in distinct clauses, in separate claims, directed to differing aspects of the claimed invention. In reality, this case was decided at the moment the '246 patent issued over five years ago, for petitioner has been afforded none of the protections against insubstantial changes mandated by this Court and Federal Circuit precedent prior to *Festo*.

B. Irreparable harm to the petitioner is avoided by a straightforward application of the law of Warner-Jenkinson.

Chief Judge Mayer's dissent points the way to a proper ruling by the Federal Circuit. App. 15a-16a. Rather than applying prosecution history estoppel to preclude analysis of the claims and the substantiality of differences with the accused device, Judge Mayer engaged in a succinct analysis that followed proper Supreme Court precedent, demonstrating its workability. In construing the language in dispute, Judge Mayer looked to the meaning of the term "or" as understood by one of ordinary skill in the art and found that "the plain meaning of 'or' can be 'either or both.'" App. 15a. Judge Mayer next analyzed the specification as a

proper source for discerning the meaning of the claim language and found that nothing in the flowcharts or written description precluded inclusion of both alternatives.[14] Having properly examined the ordinary meaning and the specification, he then analyzed the prosecution history in context to determine whether any changes were made relative to the disputed language to overcome the prior art. He found that the changes made did not distinguish over the prior art Muni Quip radar.[15] Finally, Judge Mayer recognized the existence of disputed issues of material fact. App. 16a. If there are disputed issues of material fact, summary judgment is *not* proper.

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14. "The structure and acts detailed in the specification flowcharts are consistent with this construction [of 'or']. Regardless of whether the operator selects the fastest or strongest mode, *both* the strongest and fastest signals are *always* 'searched.'" App. 15a (emphasis added).

15. "The prosecution history does not limit this construction. Kustom's addition of the 'or' limitation did not distinguish the invention over the Muni Quip MDR-1 radar device because that device also had the capacity to track the strongest or fastest signal." App. 16a. It is important to note that the "addition" referenced was in reality the submission of a separate claim incorporating a clause containing the word "or" directing claim coverage to a different aspect of the invention than the canceled claims.

CONCLUSION

This Court unanimously held in *Warner-Jenkinson* that (1) analysis of patent infringement must continue to follow the well-established "all-elements" rule, and (2) prosecution history estoppel limits the equivalents to a patent claim amended to avoid prior art. *See* 520 U.S. at 29, 31-32.

Despite a finding that all the elements of the claims at issue were "undisputedly present in the accused device," the Federal Circuit proceeded to decide infringement in the present case under the doctrine of equivalents, and in doing so affirmed summary judgment of noninfringement based on an erroneous application of prosecution history estoppel. App. 13a. Extending the reach of the new "complete bar" rule, the Federal Circuit precluded petitioner from relying on any range of equivalents to prove infringement by a device found to have all the elements of every independent claim of petitioner's patent.

For the foregoing reasons, the petition for a writ of *certiorari* should be granted.

Respectfully submitted,

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